

REMARKS

I. Introduction

Claims 1-78 are pending.

Claims 1-4, 23-36, 39, 40, 59, 65 and 66 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hawkins U.S. Patent No. 6,005,561 (hereinafter "Hawkins").

Claims 5-22, 37, 38, 41-58, 60-64 and 67-78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins in view of Official Notice.

Claims 23-28, 59-64, and 77 have been canceled without prejudice.

These rejections are respectfully traversed.

II. Summary of Personal Interview

The Examiner and the undersigned conducted a telephonic interview on August 18, 2003. The undersigned wishes to thank the Examiner for the courtesies extended during the interview.

Details of the interview will appear in the discussion below where appropriate. Generally, the Examiner and the undersigned discussed the Examiner's contention that Hawkins shows applicants' features of "receiving information from a remote source on the amount of memory for the interactive television program guide to

store the program guide data" and "adjusting the amount of memory used by the interactive program guide to store the program guide in response to the received information."

During the course of the interview, the undersigned explained his position that receiving information on the amount of memory to be used and adjusting the amount of memory "in response to the received information" is not shown or suggested by Hawkins. The undersigned believes that the Examiner agreed that Hawkins fails to show or suggest receiving information and adjusting the amount of memory "in response to the received information." Nevertheless, the Examiner maintained his contention that these features are inherently shown in Hawkins.

The Examiner, however, stated that the undersigned should set forth the arguments made during the interview in written form and that they would be considered. Thus, applicants have incorporated the concepts discussed in the interview in the Remarks below.

III. Hawkins Does Not Disclose Receiving Information
 On The Amount of Memory For the Interactive
 Television Program Guide To Use To Store The
 Program Guide Data

Common to many of applicants' independent claims (i.e., claims 1, 3, 21, 22, 37, 39, 55, 57, and 73-76) is applicants' interactive television program guide feature of "receiving information from a remote source on the amount of memory for the interactive television program guide to use to store the program guide data." The interactive television program guide adjusts the amount of memory used in response to the received information. The Examiner states that the rest of applicants' independent claims (i.e., claims 23, 29, 59, 65, 77, and 78) "correspond with subject matter rejected above in claim 1 [and] are likewise treated" (Office Action, pages 4-6).

The Examiner contends that "Hawkins explicitly discloses in Fig. 6 & Fig. 8 transmitting the size of the downloaded IPG [at] col. 17, lines 35-40" (Office Action, page 2). Applicants respectfully submit that the Examiner misreads Hawkins. According to Hawkins, FIG. 6 and 8 refers to technical information and statistics about the user terminal, such as "size requirements, overall bandwidth requirements, and transmission times" (Hawkins, column 17, lines 37-38). These statistics shown in FIGS. 6 and 8 are merely used to demonstrate the capabilities of

Hawkins' user terminal, i.e., they describe the terminal. The statistics are not information provided to the terminal or stored by the terminal in any way. Consequently, Hawkins fails to show or suggest that any of the information in the tables of FIGS. 6 and 8 are "received by the system."

Applicants respectfully request that for at least this reason, the rejections under 35 U.S.C. § 102(e) of independent claims should be withdrawn because Hawkins does not disclose receiving such information which each independent claim requires. The dependent claims are allowable at least because the independent claims are allowable.

Further patentable features and embodiments are discussed below in the sections that address the Examiner's claim rejections.

IV. Applicants' Reply to The Rejection Of
 Claims 1, 2, 19, 20, 37, 38, 56, 58, and 73

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by Hawkins. The Examiner rejected the dependent claims 19, 20, 37, 38, 56, 58, and 73 under 35 U.S.C. § 103(a) as being obvious over Hawkins in view of Official Notice.

In addition to the reason stated above in section III, applicants respectfully submit that independent claims 1, 37, and 73 are additionally allowable over Hawkins for at least the following reasons.

Hawkins, as admitted by the Examiner, does not disclose "adjusting the amount of memory used by the interactive television program guide to store the program guide data in response to the received information." While the undersigned wishes to thank the Examiner for the courtesies extended during the telephonic interview and found the discussion of memory and adjusting memory to be informative, applicants respectfully disagrees with the Examiner's contention that "this feature is inherently met by the operation of Hawkins" (Office Action, page 4).

Contrary to the Examiner's contention, inherency may not be established by possibilities. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). When a reference is silent about an asserted inherent characteristic, evidence that the missing descriptive matter is necessarily present is required. See id. Applicants respectfully submit that the Examiner has failed

to provide any such evidence with respect to his contention.

Applicants' approaches require that the system be configured to adjust the amount of memory used by the interactive television program guide to store the program guide data in response to received information. For example, as shown in FIGS. 2 and 11 and as described on pages 3-6 and 8 of applicants' specification, upon receiving information from a remote source, the system decreases the amount of memory used to store program guide data, thereby accommodating the installation of new applications or new channels in the memory. The system uses information, such as a database configuration record, to adjust the amount of memory allocated to the program guide data to ensure that sufficient memory is available to be allocated for the application.

At most, Hawkins describes an encoding scheme that compresses the program guide data before it is stored in memory or sent to the user terminal (e.g., Hawkins, column 19, line 45 to column 21, line 21). Compressing program guide data before it is delivered and stored in the user terminal has nothing to do with adjusting the amount of memory used by the interactive television program guide to store the program guide data in response to received

information (e.g., a database configuration record).

Therefore, applicants respectfully submit that Hawkins does not show the "adjusting the amount of memory used by the interactive television program guide to store the program guide data in response to the received information" feature of applicants' approaches.

Accordingly, because Hawkins does not show or suggest the features of applicants' independent claims 1, 37, and 73, claims 1, 37, and 73 are additionally allowable over Hawkins.

Claims 2, 19, 20, and 38 variously depend from claims 1 and 37, respectively, and are allowable at least because claims 1 and 37 are allowable.

V. Applicants' Reply to The Rejection Of
Claims 3-18, 39-54, and 74

The Examiner rejected claims 3, 4, 39, and 40 under 35 U.S.C. § 102(e) as being anticipated by Hawkins. The Examiner rejected dependent claims 5-18 and 51-54 under 35 U.S.C. § 103(a) as being obvious over Hawkins. The Examiner rejected independent claim 74 under 35 U.S.C. § 103(a) as being obvious over Hawkins in view of

Official Notice.*

In addition to the reason stated above in section III, applicants respectfully submit that independent claims 3, 39, and 74 are additionally allowable over Hawkins for at least the following reasons.

Independent claims 3, 39, and 74 further require reallocating the memory among the different categories of program guide data when the amount of memory used to store the program guide data is adjusted and reallocating the memory based on information in a database configuration record.

For example, whenever it is desired to add an application to a set-top box, a database configuration record may be reconfigured at the television distribution facility and retransmitted to the set-top box. This reduces the memory required by the program guide for

* The Examiner contends that claim 74 is similar to claims 21, 22, 37, 55, and 57 on page 7 of the Office Action. Contrary to the Examiner's contention, independent system claim 74 is similar to independent means-plus-function claim 3 and independent method claim 28. Further, independent system claim 74 includes the analogous features of reallocating the memory among the different categories of program guide data when the amount of memory used to store the program guide data is adjusted and reallocating the memory based on information in the database configuration record. If the Examiner believes that applicants have incorrectly determined the status of claim 74, the Examiner is invited to so state in the next communication.

storing program listings and program descriptions in its database, thereby making more memory available for non-guide applications.

The Examiner contends that applicants' feature of "reallocating the memory based on information in a database . . . is met by the various algorithms that store the EPG data using different methods, which necessarily use different storage capacity, and thus different memory locations depending upon the instant algorithm used" (Office Action, page 5).

Applicants respectfully submit that Hawkins does not show or suggest reallocating the memory based on information in a database configuration record. Rather, Hawkins' encoding scheme, as previously discussed, merely compresses the program guide data before it is stored in memory or sent to the user terminal (e.g., Hawkins, column 19, line 45 to column 21, line 21). Compressing program guide data before it is delivered and stored in the user terminal has nothing to do with reallocating the memory based on information in a database configuration record. Thus, using this encoding scheme, the set-top terminal can receive compressed program guide information. This does not mean that the set-top box can receive a database configuration record and reallocate the memory based on the

information in the database configuration record. Hawkins does not show or suggest using a database configuration record to reallocate memory.

Accordingly, because Hawkins does not show or suggest the features of applicants' independent claims 3, 39, and 74, claims 3, 49, and 74 are additionally allowable over Hawkins.

Claims 4-18 and 40-54 are dependent from claims 3 and 49, respectively, and are allowable at least because claims 3 and 49 are allowable.

VI. Applicants' Reply to The Rejection Of
Claims 21, 57, and 75

The Examiner rejected claims 21, 57, and 75 under 35 U.S.C. § 103(a) as being obvious over Hawkins in view of Official Notice.

In addition to the reason stated above in section III, applicants respectfully submit that independent claims 21, 57, and 75 are additionally allowable over Hawkins for at least the following reasons.

The Examiner correctly acknowledges the novelty of applicants' approaches over Hawkins in stating that Hawkins fails to disclose "determining an amount of memory available for each of the different categories of program guide data after the addition of new channels, wherein the

means for adjusting the memory adjusts based on the amounts of memory that are determined to be available" (Office Action, pages 7-8). However, the Examiner has taken Official Notice that such a feature is well known in the art. The Examiner therefore contends that "it was well known in the art to maintain a status of the available memory in memory storage devices" (Office Action, page 8). Applicants respectfully submit that the Examiner's Official Notice is not justified.

The Examiner may only take Official Notice of facts outside of the record which are "capable of instant and unquestionable demonstration as being 'well known' in the art" (MPEP § 2144.03). Maintaining a status of available memory in memory storage devices may be performed a number of ways depending on the desired approach. There is no objective basis to conclude that the particular approach of "determining an amount of memory available for each of the different categories of program guide data after the addition of new channels" is well known as suggested by the Examiner. Applicants also respectfully submit that the absence from the prior art already of record of "determining an amount of memory available for each of the different categories of program guide data after the addition of new channels," as opposed to

maintaining the status of available memory at any other time, belies the Examiner's assertion of Official Notice. If the Examiner insists on maintaining this rejection, applicants respectfully request that the Examiner provide a reference in support of the Official Notice used in rejecting claims 21, 57, and 75, as is applicants' right under MPEP § 2144.03.

Accordingly, claims 21, 57, and 75 are patentable and nonobvious in light of Hawkins.

VII. Applicants' Reply to The Rejection Of
Claims 22, 55, and 76

The Examiner rejected claims 22, 55, and 76 under 35 U.S.C. § 103(a) as being obvious over Hawkins in view of Official Notice.

In addition to the reasons stated above in section III, applicants respectfully submit that independent claims 22, 55, and 76 are additionally allowable over Hawkins for at least the following reasons.

The Examiner correctly acknowledges the novelty of applicants' approaches over Hawkins in stating that Hawkins fails to disclose "detecting a change in the amount of channels offered in the television channel line-up" (Office Action, page 8). However, the Examiner has taken Official Notice that such a feature is well known in the

art. The Examiner therefore contends that "[i]t would have been obvious for one of ordinary skill in the art at the time the invention was made to operate Hawkins in a manner wherein the specific items stored is known, at least for the benefit of displaying an updated channel-guide to the TV viewer's screen, so that the viewer is accurately informed of the available channels" (Office Action, pages 8-9). Applicants respectfully submit that the Examiner's Official Notice is not justified.

The Examiner may only take Official Notice of facts outside of the record which are "capable of instant and unquestionable demonstration as being 'well known' in the art" (MPEP § 2144.03). Applicants submit that the Examiner, by stating that "it would have been obvious to one of ordinary skill in the art . . . to operate Hawkins in a manner wherein the specific items stored is known, at least for the benefit of displaying an updated channel-guide to the TV viewer's screen, so that the viewer is accurately informed of the available channels" does not take notice of a fact, but instead makes a conclusion of obviousness without support. Thus, the Examiner makes conclusions of obviousness without facts to support these conclusions. If the Examiner insists on maintaining this rejection, applicants respectfully request that the

Examiner provide a reference in support of the Official Notice used in rejecting claims 22, 55, and 76, as is applicants' right under MPEP § 2144.03.

Accordingly, claims 22, 55, and 76 are patentable and nonobvious in light of Hawkins.

VIII. Applicants' Reply to The Rejection Of
Claims 29-36, 65-72, and 78

The Examiner rejected claims 29-36 and 65-67 under 35 U.S.C. § 102(e) as being anticipated by Hawkins. The Examiner rejected claims 68-72 and 78* under 35 U.S.C. § 103(a) as being obvious over Hawkins in view of Official Notice.

In addition to the reasons stated above in section III, IV, and VII, applicants respectfully submit that independent claims 29, 65, and 78 are additionally allowable over Hawkins for at least the following reasons.

* The Examiner contends that claim 78 is similar to claims 21, 22, 37, 55, and 57 on page 7 of the Office Action. Contrary to the Examiner's contention, independent system claim 78 is similar to independent means-plus-function claim 29 and independent method claim 65. Further, independent system claim 78 includes the analogous features of receiving program guide data for a new memory configuration, reconfiguring the memory to accommodate the program guide data for the new memory configuration, and reallocating the memory based on the information in a database configuration record. If the Examiner believes that applicants have incorrectly determined the status of claim 78, the Examiner is invited to so state in the next communication.

Independent claims 29, 65, and 78 further require reconfiguring the memory to accommodate the program guide data for the new memory configuration, wherein different categories of program guide data are stored in memory. The reconfiguring further includes reallocating the memory among the different categories of program guide data.

The Examiner contends that applicants' feature of "reconfiguring the memory to accommodate the EPG data according to the new memory configuration . . . [is shown at] col. 19, lines 45-65" (Office Action, page 6).

Applicants respectfully submit that Hawkins does not show or suggest reconfiguring the memory to accommodate the program guide data for the new memory configuration. Rather, Hawkins' encoding scheme, as previously discussed, merely compresses the program guide data before it is stored in memory or sent to the user terminal (e.g., Hawkins, column 19, line 45 to column 21, line 21). Again, compressing program guide data before it is delivered and stored in the user terminal has nothing to do with reconfiguring the memory to accommodate the program guide data in the new memory configuration. Thus, using this encoding scheme, the set-top terminal can receive compressed program guide information before it is stored in memory simple to "reduce the storage requirement" of the

program guide data, and not because a new memory configuration has been defined by received information (Hawkins, column 19, line 50).

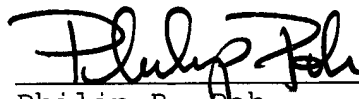
Accordingly, because Hawkins does not show or suggest the features of applicants' independent claims 29, 65, and 78, claims 29, 65, and 78 are additionally allowable over Hawkins.

Claims 30-36 and 66-72 are dependent from claims 29 and 65, respectively, and are allowable at least because claims 29 and 65 are allowable.

IX. Conclusion

The foregoing demonstrates that claims 1-78 are allowable. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



Philip R. Boh
Registration No. 51,176
Agent for Applicants
FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000